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Attorney Docket No. 9540-6

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Bredow et al.

Serial No.: 09/896,802

Filed: June 29, 2001

For: METHOD AND COMPUTER PROGRAM PRODUCT FOR USING A
SCROLLING COMPUTER MOUSE TO SELECT PAGES OF A SET OF LINKED
WEB PAGES

Confirmation No.: 8307

Group Art Unit: 2676

Examiner: Aaron M. Richer

Date: January 27, 2006

Mail Stop Appeal-Brief Patents

Commissioner for Patents

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Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. § 41.41

Sir:

This *Reply Brief* is filed in response to The *Examiner's Answer* mailed November 30, 2005.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned under 37 C.F.R. §1.136(a). Any additional fees believed to be due may be charged to Deposit Account No. 50-0220.

Reply to Arguments in the Examiner's Answer

I. Introduction

In the following sections, Appellants reply to various of the arguments set forth in the Response to Arguments section of the *Examiner's Answer*.

II. Claims 1, 14, 27 and 29 are not Anticipated by Cheng

A. The Arrows Between Boxes 42-45 Do Not Teach "Scrolling Output"

In Section II.A.1 of the *Examiner's Answer*, the Examiner concedes that the link between boxes 42 and 45 in Fig. 1 of Cheng does not expressly disclose entering the "Display Previous Page" mode **in response to a scrolling output**. (Examiner's Answer at 5). While the Examiner argues that "it seems logical to assume that a scroll wheel could be used", this argument is insufficient to support an anticipation rejection under 35 U.S.C. § 102(e). Instead, as discussed in Appellants' Appeal Brief, an anticipation rejection must include a showing that each element

of the claim at issue is taught, either expressly or inherently, by the cited prior art reference. It is undisputed that the "scrolling output" recitation of Claims 1, 14, 27 and 29 is not expressly taught by Cheng. Thus, the Examiner must prove that the "scrolling output" recitation would inherently have been present. To do so, the Examiner must show that Cheng necessarily would have used scrolling output to move between boxes 42 and 45 of Fig. 1. *Schering Corporation v. Geneva Pharmaceuticals, Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003). Inherency is not satisfied if the missing claim element would only possibly – or even probably – have been present in the prior art reference at issue. *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002).

The Examiner has not even attempted to show that Cheng necessarily would have used scrolling output to move between boxes 42 and 45 of Fig. 1. Appellants respectfully submit that such a showing cannot be made, as it is clearly the case that the "Back/Forward" label on the arrows of Fig. 1 could refer to conventional "Back" and "Forward" buttons as opposed to a scrolling output. In fact, Fig. 2 of Cheng shows that "Back" and "Forward" refer to buttons that are provided on the device of Cheng. Thus, Cheng expressly teaches that the "Back/Forward" label on the arrows connecting boxes 42 and 45 does not refer to a scrolling output. In this regard, Appellants note that the Examiner now concedes that the argument relating to the connection between boxes 42 and 45 of Fig. 1 "is not the best grounds of rejection." In any event, as the Examiner has not even argued, let alone attempted to show, that the "scrolling output" recitation is necessarily disclosed by the connection between boxes 42 and 45 of Fig. 1 of Cheng, this grounds cannot properly be relied on to support the pending rejections of Claims 1, 14, 27 and 29.

B. Cheng Does Not Disclose Determining the URL of a Web Page

In Section II.2.a of the *Examiner's Answer*, the Examiner argues for the first time that the Frame Turning mode disclosed at box 46 of Fig. 1 of Cheng inherently discloses determining the URL of a web page "because each frame on a web page is technically a separate page with a different URL. (Examiner's Answer at 5-6). Based on this argument, the Examiner takes the position that the connection between boxes 46 and 54 of Fig. 1 of Cheng disclose the "scrolling output" recitation of Claims 1, 14, 27 and 29 since those boxes

are connected by an arrow labeled "scroll" and because it is allegedly inherent that moving between frames involves determining the URL of a web page.

As an initial matter, Appellants note that the above grounds of rejection is new, having never been previously raised in the initial Office Action, in the Final Office Action, or in the Advisory Action responding to Appellants' Request for Reconsideration. This new grounds for rejection relies on a different portion of Fig. 1 of Cheng (namely box 54), and the arguments cites to different sections of Cheng (e.g., Col. 10, lines 39-67 and Col. 11, lines 1-9) that were not discussed or relied upon in the Final Office Action in support of the pending rejections.¹ While Appellants recognize that new grounds of rejection may properly be raised in the *Examiner's Answer*, the Examiner must identify such rejections as new grounds of rejection, thereby providing the Appellant the option of reopening prosecution to have a full and fair opportunity to respond thereto. 37 C.F.R. § 41.40(a)(2) and (b). Appellants have not been provided such a full and fair opportunity to respond to this new grounds of rejection, and hence to the extent that the Board of Patent Appeals and Interferences relies on this newly raised grounds of rejection, such reliance should be treated as a new grounds of rejection so that Appellants will receive a full and fair opportunity to respond to such rejection in prosecution.

Appellants also respectfully submit that the newly raised ground of rejection does not show anticipation of Claims 1, 14, 27 or 29. The connection between boxes 46 and 54 of Fig. 1 of Cheng is described in Cheng with respect to Figs. 1 and 8. (See Cheng at Col. 1, lines 51-53, Col. 8, lines 42-49 and Figs. 1 and 8). As shown in Fig. 8, each "frame" refers to a separate portion of an already accessed web page that is already being displayed to the user on the display device. As made clear by the description at Col. 1, lines 51-53 and Col. 8, lines 42-49 of Cheng, the arrows labeled "scroll" connecting boxes 46 and 54 of Fig. 1 of Cheng refer to using the scroll input to highlight or select one of the already displayed frames. As such, box 54 of Cheng does not disclose determining a URL of a web page "responsive to a scrolling input" and then "accessing the [associated] web page by a web

¹ In fact, in the Final Office Action that Examiner stated that box 54 of Fig. 1 related "to another function of Cheng" as opposed to the function of Cheng on which the rejections were based. (See Final Action at 8).

browser" as recited in Claim 1, but instead merely discloses moving a highlight through a plurality of already displayed frames on an already accessed web page.

Section II.2.a of the *Examiner's Answer* also argues that the "scrolling output" recitation of Claims 1, 14, 27 and 29 is taught by the connection between boxes 46 and 45 in Fig. 1 of Cheng. In particular, the Examiner argues that since the "Back" or "Forward" buttons may be used to access box 45, this implies that box 45 involves obtaining the URL for a web page. However, as implicitly conceded in the *Examiner's Answer*, Cheng does not expressly disclose that the connection between boxes 46 and 45 involves determining the URL of a web page in response to a scrolling output as recited in Claims 1, 14, 27 and 29. Thus, the Examiner has the burden of showing that this inherently or "necessarily" would occur. No attempt to meet this burden has been made in the *Examiner's Answer*. Instead, the Examiner merely states that there is an implication that this might happen. Such an implication is insufficient to establish inherency. *Rosco, Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 1380 (Fed. Cir. 2002). Here, the portions of Cheng cited in Appellants' Appeal Brief show that the connection between box 46 and 45 is used to navigate a single web page. There simply is no disclosure in Cheng that the connection between boxes 46 and 45 involves determining the URL of a web page in response to a scrolling output, and no showing that this would inherently occur has been, or could be, made.²

Accordingly, Appellants respectfully submit that the rejections of Claims 1, 14, 27 and 29 should also be reversed.

² As discussed in Appellants' Appeal Brief, Col. 6, lines 13-19 of Cheng makes clear that the Display Previous Page Mode (box 45) is used for **backward or forward movement through highlighted or selected text**. (See Appeal Brief at 8).

C. Box 45 of Cheng is Not Entered in Response to a Scrolling Output

The rejections of Claims 1, 14, 27 and 29 should also be withdrawn because these rejections are based on the assumption that the Display Previous Page Mode (box 45) of Fig. 1 is entered in response to a scrolling signal. (See Final Office Action at 2, ¶ 3 and 8, ¶ 25). As Appellants have explained, **Fig. 1 of Cheng expressly shows that when a scrolling signal is received while in Frame Turning Mode (box 46), the scrolling signal causes the remote control to enter the Turn to Frame Mode (box 54) as opposed to the Display Previous Page Mode (box 45).** (See Cheng at Fig. 1 and Col. 6, lines 51-54). The Examiner argues that the scroll signal of Cheng could have two functions such that "a scroll signal in one direction may have one effect, while a scroll signal in another direction may have a second effect." (Examiner's Answer at 8). However, what the specification of Cheng states is that "Box 54 denotes the advancing or regression of frames due to a scrolling signal." (Cheng at Col. 6, lines 51-53). This clearly indicates that scroll signals in either direction move operations from box 46 to box 54, directly contradicting the Examiner's suggestion that scroll signals in one of two directions would move operations to box 45. Thus, Appellants also submit that, when read in its entirety, Cheng does not teach that the Display Previous Page Mode (box 45) is entered in response to a scrolling output. This provides an independent basis for withdrawal of the rejections of Claims 1, 14, 27 and 29.

III. **Claims 3-4, 8-13, 16-17, 21-26 and 28 are Patentable Over the Cited Art**

A. Claims 3-4, 9, 12-13, 16-17, 22, 25-26 and 28

As pointed out in Appellants' Appeal Brief, the rejections of Claims 3-4, 9, 12-13, 16-17, 22, 25-26 and 28 should be withdrawn because Cheng does not teach or disclose the operations involving a "set of linked web pages" that are recited in these claims. In response, the Examiner argues that "previous pages [stored in a browser history] can be considered linked to a current page." (Examiner's Answer at 10-11). However, as set forth above and in Appellants' Appeal Brief, Cheng does not teach or disclose that the Display Previous Page Mode retrieves a different web page having a different URL, let alone that it is retrieving a web page that is one of a linked set of web pages as recited in Claims 3 and 16. Accordingly, the rejections of Claims 3 and 16, and the claims depending therefrom, should be reversed.

B. Claims 8, 10-11, 21 and 23-24

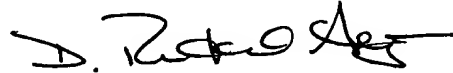
Each of Claims 8, 10-11, 21 and 23-24 involve determining the URL of a web page where the URL is associated with either the "next" button of a source page and/or a "previous" button of the source page. The Examiner takes the position that "Back" and "Forward" buttons – which are disclosed in Cheng – are similar to "Next" and "Previous" buttons, and that therefore "it would be obvious to one skilled in the art that the Cheng reference can be used to scroll to 'next' or 'previous' hyperlink and determine an associated URL." (Examiner's Answer at 12-13). The Examiner's position, however, is directly refuted by the Cheng reference itself.

In particular, according to embodiments of the present invention, a web browser may enter a scrolling mode in which a scrolling output is used to invoke "Next" and "Previous" functions in order to more conveniently browse through a linked list of web pages such as search results or an online catalog. While the Examiner argues that it is obvious that Cheng discloses such functionality, what Cheng in fact states is that a user may use a scroll wheel to move between hyperlinks on a page. (Cheng at Col. 8, lines 10-19 and Figs. 4-5). Thus, Cheng is clear that scrolling output is used to move between hyperlinks, but there is no teaching or suggestion that a scrolling output is used to determine a URL for, and then access, the webpage associated with the hyperlink, as is recited in the invention of, for example, Claim 8. In fact, as the scrolling output is being used to move between hyperlinks, it is clear that it cannot also be used to implement a different function (namely jumping to the hyperlink). Thus, Appellants respectfully submit that it is beyond dispute that Cheng does not teach or disclose the inventions of Claims 8, 10-11, 21 and 23-24 and, accordingly, the rejections of these claims should be reversed for this additional reason.

IV. Conclusion

In light of the above discussion, Appellants submit that each of the pending claims is patentable over the cited references and, therefore, request reversal of the rejections of Claims 1-29.

Respectfully submitted,

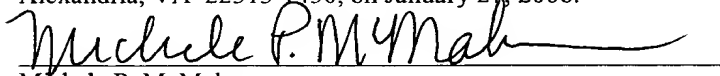


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal-Brief Patents, Commissioner for Patents, P.O. box 1450, Alexandria, VA 22313-1450, on January 27, 2006.



Michele P. McMahan

Date of Signature: January 27, 2006